

## REMARKS

Claims 1-26 were present in the application as filed. Claims 10, 16, 19-22 and 25 were amended to eliminate multiple dependencies in a preliminary amendment that accompanied the application on filing. Claims 1, 5, 8, 11, 14, 15, 18 and 26 are amended above. Claims 1-26 are pending.

The Office Action of September 6, 2006, indicated that claims 11-19 and 23-25 would be allowable if amended to include the limitations of the claims from which they depended. Claims 11, 14, 15 and 18 have been amended to conform them to the claims from which they depend.

In the Office Action of September 6, 2006, claims 1-10, 20-22 and 26 were rejected under 35 USC §102(b) and §103(a) as anticipated or obvious over Urban et al. US patent 4,717,605. In light of the amendments above, reconsideration is requested.

Urban discloses radiation curable adhesives based on ionically polymerizable epoxides. These compositions additionally contain “at least one ethylenically unsaturated substance which can be polymerized by free radicals” and “at least one free radical photoinitiator”. “At least one ethylenically unsaturated monomer that can be polymerized by free radical polymerization” is a required element of both the generically disclosed invention and the claims. Applicants’ independent claims 1, 5, 8, and 26 have been amended to require that the catalyst component consists of only the cationic photoinitiator and that the pre-irradiation mixture contains no ethylenically substituted monomers that can be polymerized by free radicals. Since both of these elements are required by Urban, rejection under 35 U.S.C. 102(b) is overcome. Moreover, because Urban requires the ethylenically unsaturated monomer and the free radical photoinitiator, there is no motivation to remove them from his compositions. Therefore, the now pending claims are also unobvious over Urban.

The phrase, “containing no ethylenically substituted monomers that can be polymerized by free radicals” does not occur *in haec verba* in applicant’s specification. Applicant notes that,

in order to comply with the written description requirement, the specification “need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed.” [All Dental Prodx LLC v. Advantage Dental Products Inc., Fed. Cir., No. 02-1107, 10/25/02]. In the present case, the description (e.g. paragraph [0013]) clearly indicates that the invention requires a mixture of certain specified cationically polymerizable oxiranes or oxetanes and a photoinitiator. The description of the reaction as a cationic polymerization (paragraph [0039]) makes it abundantly clear that free radical polymerization would not fall within the scope of the invention. Acrylic, vinylic, allylic and other ethylenically substituted monomers (Urban column 4, line 5) would be unsuitable for the claimed compositions. Therefore, applicant urges that implicit support exists for the phrase now introduced into the claims.

As the CCPA observed in *In re Wertheim* [191 USPQ 90 (1976)] “We must decide whether the invention appellants seek to protect by their claims is part of the invention that appellants have described as theirs in the specification. That what appellants claim as patentable to them is less than what they describe as their invention is not conclusive if their specification also reasonably describes what they do claim. Inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable. As we said in a different context, [citation omitted] to hold otherwise would let form triumph over substance, substantially eliminating the right of an applicant to retreat to an otherwise patentable species merely because he erroneously thought he was first with the genus when he filed.” In the present case, it is clear that what is presently claimed is what the inventor invented.

There being no other outstanding issues, the application is believed in condition for allowance and such is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Philip E. Hansen", written over a horizontal line.

Philip E. Hansen  
Registration No. 32,700  
Agent for Applicants

Dated: December 6, 2006

**HESLIN ROTHENBERG FARLEY & MESITI, P.C.**

5 Columbia Circle

Albany, New York 12203

Telephone: (518) 452-5600

Facsimile: (518) 452-5579